

REMARKS

Summary of the Office Action

Claims 1 and 3-5 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over admitted Prior Art submitted by Applicants in view of *Goenka et al.* (U.S. Patent No. 5,968,386).

Claim 2 is indicated as including allowable subject matter.

Summary of the Response to the Office Action

Applicants have amended canceled claim 2 without prejudice and disclaimer, and amended claims 1 and 5 to more clearly define the invention. Accordingly, claims 1 and 3-6 are presently pending with claims 1, and 3-5 being under consideration and claim 6 being withdrawn from consideration.

Attached hereto is a marked-up version of the changes made by the current amendment. The attached page is captioned, "VERSION WITH MARKINGS TO SHOW CHANGES MADE."

The Disposition of the Claims

Claims 1 and 3-5 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over admitted Prior Art submitted by Applicants in view of *Goenka et al.* Applicants thank the Examiner for the indication of allowable subject matter in claim 2.

Applicants respectfully submit that independent claims 1 and 5, as newly-amended, are allowable at least because the subject matter of claim 2, which has been indicated as being allowable in this Office Action, are incorporated into claims 1 and 5, respectively. Withdrawal of the rejection of claim 1 under 35 U.S.C. §103(a) is thus respectfully requested. Further, withdrawal of the rejections of claims 3 and 4 is also respectfully requested at least because of their dependencies on newly-amended claim 1 and for the reasons set forth above.

With no other rejections pending, Applicants respectfully assert that claims 1, and 3-5 are in condition for allowance.

Conclusion

In view of the foregoing, Applicants respectfully request entry of the amendments to place the application in clear condition for allowance or, in the alternative, in better form for appeal. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such extension is requested and the fee should also be charged to our Deposit Account.

Respectfully Submitted,

MORGAN, LEWIS & BOCKIUS LLP

By:



Robert J. Goodell
Registration No. 41,040

Date: January 17, 2003

CUSTOMER NO. 009629
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, DC 20004
202-739-3000 (Phone)
202-739-3001 (Fax)

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Please amend claims 1 and 5 as follows:

1. (Twice Amended) A noise protection sheet stuck on electronic components loaded on a circuit board to suppress noise generated from the electronic components, comprising:

- a metallic sheet, and
- insulating films which sandwich the metallic sheet in-between thereof,
- wherein

said metallic sheet has, at its one end, an extending portion being externally exposed and being connected to a grounding terminal on the circuit board, **and said metallic sheet has a first area covered with said insulating films and a second area forming the extending portion.**

5. (Amended) An apparatus for mounting a noise protection sheet on electronic components loaded on a circuit board, the noise protection sheet comprising a metallic sheet and insulating films sandwiching said metallic sheet in-between, further comprising:

- carrying means for carrying said noise protection sheet held on a carrier tape;

- moving means for chucking said noise protection sheet and moving it from the carrier tape onto the electronic components on said circuit board; and

- soldering means for soldering an extending portion externally exposed and formed at the one end of said metallic sheet to a grounding terminal of said circuit board[-].

wherein said metallic sheet has a first area covered with said insulating films and a second area forming the extending portion.

Claim 2 has been canceled.